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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/075,779  | 02/13/2002  | Satoshi Mizutani     | 2309/0K299          | 9184             |
| 7278  | 7590        | 08/22/2005           | EXAMINER            |                  |
| DARBY & DARBY P.C.<br>P. O. BOX 5257<br>NEW YORK, NY 10150-5257 |             |                      | REICHLE, KARIN M    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |

3761

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TJH

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/075,779             | MIZUTANI ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Karin M. Reichle       | 3761                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-23 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 9-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-8 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 3-4, and 9-22 are still withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4-27-04.

### *Specification*

#### *Drawings*

2. The drawings were received on 4-29-05. These drawings are approved by the Examiner.

### *Description*

3. The substitute specification filed 4-29-05 has been entered.

### *Claim Language Interpretation*

4. Since Applicants have not defined any claim terminology specifically, the terminology will be given its common, i.e. dictionary, definition. It is noted that the amendments claims 5-8, line 1, i.e. "Claim" was changed to --claim--, did not comply with 37 CFR 1.121. The next response, if any, should be compliant with 37 CFR 1.121.

***Claim Objections***

5. Claims 1, 5-8 and 23 are objected to because of the following informalities: in claim 1, line 10, after “layer”, --, respectively, -- should be inserted and on line 10, “,” should be deleted. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura ‘082 in view of Kielpikowski ‘896 and Suzuki et al ‘975.

Claims 1 and 23: See Figures, especially 1-3, abstract, page 4, lines 19-22, page 8, line 4- page 9, line 13, page 12, lines 17-21, page 15, lines 5-7 and 14-22, and claims, i.e. the back layer is 20, the absorbent is 31 or 33, the three dimensional portion is at least the layer 10 of 40 having fixed ends adjacent 31 in Figures 2 and 3, a skin contactable portion 31a and connecting portions therebetween, the elastic members at the free ends are 50, see also Figures 3 and 4, the longitudinal ends of 10, i.e. the three dimensional portion, are fixedly folded entirely to the main body, see cross hatched areas in Figures 1 and 4 and page 9, lines 11-13. It is noted that the claims, for example, teach that a pressure sensitive adhesive is not required on the back layer during use. Therefore the Kimura device includes all the claimed structure except for two elastic members spaced inward from the elastic members at the free ends, i.e. each free end portion includes two elastic members one spaced inwardly of the other. First, it is noted that the first full paragraph on page 9 of the substitute specification does not set forth the criticality of such an

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arrangement nor did the original specification. Furthermore, Kimura et al teaches the three dimensional structure, i.e. the width of the skin-contacting portion and the height of the three dimensional structure, and string-like elastic members, i.e. the upward elevation thereby, provide an article which conforms to the wearer's body and capable of preventing leakage irrespective of the movement of the wearer. Similarly, Kielpikowski teaches a three dimensional structure with elasticized free ends which provide a surface which conforms to the wearer's body and prevents leakage, see Figures and col. 2, line 52-col. 4, line 25. Kielpikowski at col. 5, lines 13-18 and the Figures further teaches the elastication of each free end portion due to either a single member at the free end or two or more members with one at a free end and one spaced inwardly thereof. Suzuki '975 also teaches a three dimensional structure with an elasticized free ends which provides a surface which conforms to the wearer's body and prevents leakage, see Figures and col. 6, lines 27-45. Suzuki et al at col. 8, lines 51-63 and the Figures teach the elastication of the free end portion with a member which is "any of elastic members ordinarily used for absorbent articles" which can be at least one in number or when such is in the form of a string, is at least two in number, one inwardly of the other, to more effectively maintain the shape and better prevent leakage. Therefore to make the one elastic member in each free end of the Kimura device each two elastic devices, one of which is at the end and one which is spaced inwardly thereof, would be obvious to one of ordinary skill in the art either in view of the interchangeability as taught by Kielpikowski and Suzuki or in view of the recognition that such would more effectively maintain the shape of the three dimension portion for the purposes of leakage prevention and the desire of Kimura to maintains its desired shape and be capable of leakage prevention.

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8. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura '082, Kielpikowski '896 and Suzuki et al '975 as applied to claim 1 above and further in view of Mayer et al '614.

Claims 7-8: The Kimura reference teaches a sanitary napkin which absorbs body fluid and fits to the wearer's body having a centrally located elasticated three dimensional member which rises from the remainder of the napkin which member has a width of 10mm to 50mm and appears to be about 1/3 of the total width of the napkin and has a length of 15% to 90% of the entire length of the napkin. Applicants claim a three dimensional portion having not only a width of 20mm to 40mm but a length of between 50-70mm and a main body which has a width of 40-60mm and a length of 80-120mm which are not clearly taught by Kimura (as noted above the length of the three dimensional member is expressed as a percentage of the length of the main body). However, Mayer et al '614 also teaches a sanitary napkin which absorbs body fluid and fits to the wearer's body having a centrally located three dimensional member which may be elasticated and rises from the remainder of the napkin and not only has lengths and widths commensurate with those set forth by Kimura but also the lengths and widths claimed as well. See, e.g., Figures, col. 1, lines 6-12, col. 3, lines 66-67, col. 8, lines 19-27, col. 11, lines 12-22, col. 13, lines 55 et seq. Therefore, to employ the dimensions as taught by Mayer et al on the Kimura device (if not already taught by Kimura) would be obvious to one of ordinary skill in the art in view of the recognition that such dimensions are known for sanitary napkins which absorb body fluids and fit to the wearers body having a centrally located three dimensional member which rises from the remainder of the napkin and the desire of Kimura to define such a napkin.

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Claims 5-6: Claims 5-6 recite the intended use of the structure of claim 1. Such intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). At most the structure defined by the intended use language is a skin contacting portion of a size to be received and retained within labia of a wearer. See discussion of claims *supra*, as well as page 9, lines 6-8, page 12, lines 17-21 and page 15, lines 14-22 of Kimura again and the cited portions of Mayer as well as col. 4, lines 11-16 and col. 11, lines 12-27, i.e. not only are the dimensions taught by the prior art combination the same as those of the claimed invention but the prior art also explicitly teaches such dimensions permit receipt and retention between the labia. Therefore such intended use recitation does not structurally distinguish over the structure taught by the prior art combination. Furthermore, there is sufficient factual basis, see discussion *supra*, for one to conclude that the prior art combination structure would also necessarily and inevitably be capable of performing such intended use.

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***Response to Arguments***

9. Applicant's remarks have been considered but are either deemed moot in that the issued discussed has not been reraised or is deemed not persuasive for the reasons set forth supra.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by the amendments made to claim 1 as well as the addition of new claim 23.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
August 16, 2005